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BAC

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UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re International Business Machines Corporation

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Serial No. 75/251,064

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Alexander Tognino, Esq. of International Business Machines Corporation for applicant.

Russ Herman, Trademark Examining Attorney, Law Office 102 (Thomas V. Shaw, Managing Attorney).

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Before Chapman, Bottorff and Holtzman, Administrative Trademark Judges.

Opinion by Chapman, Administrative Trademark Judge:

International Business Machines Corporation has filed an application to register on the Principal Register the mark DATAHIDING for "electronic apparatus for protection of information signals" in International Class 9, and "services for providing security protection to information signals" in International Class 42.<sup>1</sup>

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<sup>1</sup> Application Serial No. 75/251,064, filed March 4, 1997. Both classes in the application are based on applicant's assertion of a bona fide intention to use the mark in commerce. This appeal involves both classes of goods and services.

Registration has been finally refused under Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), on the ground that applicant's mark, if used on or in connection with the stated goods and/or services, is merely descriptive of them.

Applicant has appealed. Both applicant and the Examining Attorney have filed briefs. An oral hearing was not requested.

The Examining Attorney contends that the applied-for mark immediately describes a significant function or feature of applicant's stated goods and services, specifically, the security protection of information signals (through the concealment of programming code). More specifically, he asserts as follows:

"'Data hiding,' also known as steganography[,] is a new technology which deals with concealment of information within various forms of media. (See Applicant's exhibit C) For example, data hiding can be used to embed text in sound or images. This technique is used for hiding or concealing data such as captions, copyright information and other desired annotation within media in a storage independent format. Instead of scrambling messages such as in cryptography, data hiding actually hides the presence of communication entirely. By using steganographic protocols, the necessary information can be relayed without raising any

suspicious as to its presence."  
(Brief, p. 4); and

"Data hiding is a merely descriptive designation whether it is data being directly concealed, hidden or obscured by the technology or whether it [is] an encryption scheme associated with the data that is being concealed, hidden or obscured." (Brief, p. 6).

In support of his refusal to register, the Examining Attorney submitted the following dictionary definitions<sup>2</sup>:

(i) from the Computer Glossary the definition of "data" as "(1) Technically, raw facts and figures, such as orders and payments, which are processed into information, such as balance due and quantity on hand. However, in common usage, the terms data and information are used synonymously....";

(ii) from the Random House College Dictionary definition of "hide" as "1. to conceal from sight; prevent from being seen or discovered"; and

(iii) from the Computer Glossary the definition of "hidden file" as "A file classification that prevents a file from being accessed. It is usually an operating system file; however, utility programs let users hide files to prevent unauthorized access.

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<sup>2</sup> In his appeal brief the Examining Attorney requested that we take judicial notice of an attached printout of a "dictionary definition" from Techtarget.Com, Inc. The request is denied. The printout is not subject to judicial notice because (i) the nature of the source (Techtarget.Com, Inc.) is not clear, and (ii) this information does not constitute a "fact of universal notoriety, which need not be proved." This printout was not considered.

The Examining Attorney also submitted copies of excerpts of published stories retrieved from the Nexis database referring to "data hiding" in computer systems, examples of which are set forth below (emphasis added):

(1) HEADLINE: How the government looks at security/secure computer systems.

...security administrator when they occur. If the unauthorized actions continue, the system can terminate the event. The B3 TCB uses layering, abstraction, and **data hiding** for protection, and excludes modules that are not protection-critical, "The Network Journal," December 1994;

(2) The process of **data hiding** is as ancient as cryptography, as a quick look at The Codebreaking will reveal. As for hiding information in image files, there have been..., "Information Security," October 1999;

(3) ...Signafy, a company that develops digital-watermarking and **data hiding** solutions, sells its software from its own site. Products are available for outright purchase or as try-before-you-buy demos, "Computer Shopper," October 1, 1999;

(4) HEADLINE: Copy Protection for DVD-Audio

These are primarily the same companies that developed the Contents Scrambling System for DVD-Video, and the proposals use a mix of **data hiding** (digital watermarking) and a copy control flag, similar to the SCMS system used on domestic DAT, "One to One," April 1999;

(5) ... applied to DVD-Audio's content control and protection. The three key elements of copy protection for DVD-Audio are encryption, **data hiding** (data watermarking) and Content Control Information instructions, "One to One," May 1999;

(6) ...In addition to audio coding technology, Fraunhofer IIS is also working on **data-hiding** technologies for use in watermarking and fingerprinting systems....., "M2 Presswire," February 26, 1999; and

(7) HEADLINE: Digital watermarking; Protection from Internet Pirates

...tell exactly where the technology is going. There are so many possibilities of application.' Better than 90 percent of all publications in the field of **data-hiding** in digital imagery has been done in the last five years. Aside from identifying the author of the copyrighted image, the design of the watermark....

...will derive similar benefits, which include authenticating source or content to detect tampering and tracing of unauthorized disclosure of digital images. **Data hiding**, also known as steganography, is closely related to the classic form of message scrambling known as cryptography, but far more sophisticated, "Central New York Business Journal," December 21, 1998.

Applicant agrees that generally "data hiding" is a type of "steganography," and "at its most general, 'data hiding' may be defined as the concealment of information within various forms of media." (Brief, p. 4). But, applicant contends that none of the definitions accurately

describes applicant's identified goods and services, which applicant explains as follows:

Applicant's goods and services have to do with the security and protection of information in electronic form. The ultimate purpose and function of the goods and services do not have to do with preventing electronic information from being visible, but rather to protect electronic information from being stolen or misappropriated. (Applicant's response filed March 24, 1998, p. 4); and

These goods and services are of use to anyone associated with creating or distributing digital content, such as authors, and producers or distributors of music and DVDs (Digital Versatile Disks). For example, an authorized reproduction studio or copyright agency could use Applicant's goods and services to detect and prevent unauthorized copies of digital content. The makers of electronic components could use Applicant's goods and services in their products to prevent unauthorized copying of copyrighted material, such as music. Applicant's product hides the encryption scheme associated with the data, but not the data itself, although it does allow the user to tell if someone has copied the scheme by looking at the encryption scheme. ... Datahiding is a coined term for the encryption scheme.<sup>3</sup> (Brief, pp. 6-7).

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<sup>3</sup> We note that the mark shown in the original drawing was DATA HIDING, but applicant amended the drawing to delete the space between the words, contending that this "renders the mark a coined word." (Applicant's response filed March 24, 1998, p. 5). In this case, we disagree that such a change converts the descriptive terms into a coined word. See, e.g., *In re Gould Paper Corporation*, 834 F.2d 1017, 5 USPQ2d 1110 (Fed. Cir. 1987).

Applicant further contends that several of the Nexis stories submitted by the Examining Attorney show that there are many definitions of the term within the computer industry (e.g., in the senses of "data opacity," "data hoarding," "software development tool") and the number of alternative definitions and uses of the term is determinative that "datahiding" is not merely descriptive of the involved goods and services; that there are numerous possible meanings requiring purchasers to use thought or imagination to extrapolate the specific meaning here; that the common term for applicant's goods and services is "digital watermarking" or alternatively, "digital audio watermarking" or "watermarking"; that there are numerous marks on the Principal Register which include the term "DATA"; and that if registered, applicant acknowledges that it "would not have the right to prevent others from using the term 'data hiding' fairly in a descriptive, non-trademark, non-confusing manner." (Emphasis in original) (Brief, p. 11).

The test for descriptiveness is well settled. A term is considered merely descriptive within the meaning of Section 2(e)(1), if, when considered in conjunction with the goods with which it is intended to be used, it immediately and forthwith conveys information about the

nature of the goods, or about a quality, characteristic, feature, purpose or function thereof. See *In re MetPath Inc.*, 223 USPQ 88 (TTAB 1984). It is not necessary that the term describe all of the properties or functions of the goods or services in order for the term to be considered merely descriptive thereof; rather it is sufficient if the term describes a significant attribute or idea about them. And, of course, whether a term is merely descriptive is determined not in the abstract, but in relation to the goods or services for which registration is sought and the possible significance that the term may have to the average purchaser of the goods or services because of the manner of its use. See *In re Bright-Crest, Ltd.*, 204 USPQ 591, 593 (TTAB 1979). See also, *In re Consolidated Cigar Co.*, 35 USPQ2d 1290 (TTAB 1995); and *In re Pennzoil Products Co.*, 20 USPQ2d 1753 (TTAB 1991). The question is not whether someone presented with only the mark could guess what the goods are. Rather, the question is whether someone who knows what the goods are will understand the mark to convey information about them. See *In re Home Builders Association of Greenville*, 18 USPQ2d 1313 (TTAB 1990).

We agree with the Examining Attorney that the evidence of record clearly indicates that the term "DATAHIDING" is merely descriptive of applicant's goods and services. That



is, the evidence before us shows that the term refers to a technique (encompassing both applicant's goods and services) in the computer security field whereby data is concealed through digital technology in order to provide security for the document.<sup>4</sup>

As noted above, the test is not whether a consumer can guess what the goods and/or services are from the mark, but rather whether, when the consumer sees the mark on or in connection with the goods and/or services, it immediately conveys information about them. In the context of applicant's goods and services, consumers will understand the term to refer to a significant function or feature of both the apparatus for and the service of protecting information signals; and consumers will immediately understand this without using imagination. When the Nexis evidence referring to "data hiding" which is quoted above, is viewed together with the dictionary definitions in the record of the terms "data," "hide" and "hidden file," we are of the opinion the term DATAHIDING is merely descriptive of the goods and services on which applicant intends to use the mark, i.e., "electronic apparatus for

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<sup>4</sup> As the Examining Attorney said in his denial of applicant's request for reconsideration, "'Datahiding' is part of an emerging, wide open field in which the technology has many possibilities and many applications."

protection of information signals," and "services for providing security protection to information signals." That is, the term immediately and without conjecture or speculation describes a significant feature or function of applicant's goods and services.

The case of *In re TMS Corporation of the Americas*, 200 USPQ 57 (TTAB 1978) (THE MONEY SERVICE not merely descriptive of financial services wherein funds are transferred to and from a savings account from locations remote from the associated financial institution), cited by applicant, does not require a different result here. In that case, the Board noted the "thin line of demarcation between a suggestive term and a merely descriptive designation," and specifically found that the term suggested a number of things but fell short of describing applicant's services "in any one degree of particularity," and that consumers would have to use "thought, imagination and perhaps an exercise in extrapolation." We do not find such a broad general meaning of the term "datahiding," and there is no such need for extrapolation to understand the term with regard to applicant's goods and services.

In view of the evidence made of record by the Examining Attorney, we have no doubt that when consumers see applicant's goods or advertisements for applicant's

services bearing the term "DATAHIDING," the term would immediately inform prospective purchasers of the significant feature of the goods and services relating to security protection of information signals. See *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987) (APPLE PIE merely descriptive for potpourri); *In re Omaha National Corporation*, 819 F.2d 1117, 2 USPQ2d 1859 (Fed. Cir. 1987) [FIRSTIER (stylized) merely descriptive for banking services]; and *In re Copytele Inc.*, 31 USPQ2d 1540 (TTAB 1994) (SCREEN FAX PHONE merely descriptive of facsimile terminals employing electrophoretic displays).

Applicant's argument based on the PTO's allowance of several other "'data'-formative marks" for various computer goods is of no avail. The Board does not have the records of those files before us, and each case must be decided on its own record. See *In re Scholastic Testing Service, Inc.*, 196 USPQ 517 (TTAB 1977).

**Ser. No.** 75/251064

Decision: The refusal to register under Section  
2(e)(1) is affirmed.

B. A. Chapman

C. M. Bottorff

T. E. Holtzman  
Administrative Trademark Judges,  
Trademark Trial and Appeal Board